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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,418	03/29/2001	Thomas Innerarity	22000205911	9795

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EXAMINER

NGUYEN, BAO THUY L

ART UNIT	PAPER NUMBER
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1641

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DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,418

Applicant(s)

INNERARITY ET AL.

Examiner

Bao-Thuy L. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11 drawn to a method for identifying compounds that affect LDL-proteoglycan binding, classified in class 435, subclass 7.1, for example.
- II. Claims 12-13, drawn to compounds identified by a screening assay, classified in class 436, subclass 182, for example.
- III. Claims 14-21, drawn to a polypeptide, classified in class 530, subclass 300, for example.
- IV. Claim 22, drawn to an antibody, classified in class 530, subclass 387.1, for example.
- V. Claims 23-25, drawn to a polynucleotide, classified in class 536, subclass 23.1, for example.
- VI. Claim 26, drawn to an expression system, classified in class 424, subclass 93.21, for example.
- VII. Claim 27, drawn to a non-human animal, classified in class 800, subclass 2 for example.
- VIII. Claim 28, drawn to a method for preventing the severity of atherosclerosis, classified in class 514, subclass 44, for example.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP \square 806.04, MPEP \square 808.01). In the instant case the different inventions are not disclosed as capable of use together. The method of group I does not material affect the compound of group II. The protein of group III is not required in the method of group I. The antibody of group IV is not required in the method of group I. The polynucleotide of group V is not required in the method of group I. The expression system of

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Group VI is not required in the method of group I. The transgenic animal of group VII is not required in the method of group I, and the method of group VIII is different from the method of group I.

3. Inventions II and III-VIII are unrelated. The compound of group II is not related to the protein of group III, or the antibody of group IV or the polynucleotide of Group V or the expression system of group VI or the transgenic animal of Group VII or the method of Group VIII.

4. Inventions III and IV-VIII are unrelated. The polypeptide of Group III is chemically and biologically distinct from the antibody of Group VI, the polynucleotide of Group V, the expression system of Group VI, the transgenic animal of group VII and is not required in the method of group VIII.

5. Inventions IV and V-VIII are unrelated. The antibody of Group IV is chemically and biologically distinct from the polynucleotide, the expression system, the transgenic animal and the method as claimed in Groups V-VIII.

6. Inventions V and VI-VIII are unrelated. The polynucleotide of Group V is chemically and biologically distinct from the expression system, the transgenic animal and the method as claimed in Groups VI-VIII.

7. Inventions VI and VII-VIII are unrelated. The expression system is chemically and biologically distinct from the transgenic animal and the method as claimed in Groups VII-VIII.

8. Inventions VII and VIII are related. The transgenic animal of Group VII is chemically and biological distinct from the method of Group VIII.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not required for Groups II-VIII, restriction for examination purposes as indicated is proper.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Sequence Compliance


12. This application contains sequence disclosures that are encompassed by the definition for nucleotide and/or amino acid sequences set forth in 37 C.F.R. 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. 1.821-25 because the CRF is required but has not been submitted. Applicant is given ONE MONTH from the date of this letter, running concurrently herewith, within which to comply with the sequence rules. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 C.F.R. 1.821(g). Extension of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 C.F.R. 1.136. In no case may an applicant extend the period for response beyond the six-month statutory period.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao-Thuy L. Nguyen whose telephone number is (703) 308-4243. The examiner can normally be reached on Tuesday - Thursday from 9:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703) 305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Bao-Thuy L. Nguyen
Primary Examiner
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May 27, 2003